

Remarks

The present amendment responds to the Official Action dated March 22, 2005. A petition for a two month extension of the time to respond and authorization to charge Deposit Account No. 50-1058 the fee for this extension accompany this amendment. The Official Action rejected claim 14 under 35 U.S.C. 101 as directed to non-statutory subject matter. Claims 1-7 and 14-17 were rejected under 35 U.S.C. 103(a) based on Price Watch Corporation ("Price Watch") in view of Home Gain.com, Inc. ("Home Gain"). The Price Watch and Home Gain materials were pages printed out from web-archive.org. In a brief telephone interview on June 6, 2005, clarification was sought and provided as to what date the Examiner considered the various Price Watch and Home Gain pages to be prior art. Claims 8-13 and 18-20 were rejected under 35 U.S.C. 103(a) over Price Watch and Home Gain in further view of Grandcolas et al. European Patent EP 1,089,516 ("Grandcolas"). These grounds of rejection are addressed below. Claim 12 has been amended to correct a typographical error. Claims 14 and 15 have been amended to be more clear and distinct. Claims 1-20 are presently pending.

Interview Summary

In a brief telephone interview on June 6, 2005, the undersigned sought clarification as to what date the Price Watch (pp. 1-35) and Home Gain (pp. 1-59) materials relied upon were considered to be prior art. It was noted that the various pages had several different dates on them. By way of example, Price Watch p. 1 is attached hereto as Exhibit A. It is seen that this page has a copyright "© 2001", a heading "Search Results for Jan 01, 1996 – Nov 23, 2002", and a box with the date "Saturday, November 23, 2002". It also includes lists of a large number of pages of varying dates, many of which are not in the collection of pages provided by the

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Examiner, and several of which are after the October 24, 2001 filing date of the present application. Other pages have several different dates.

The Examiner clarified that he was relying upon the dates in the url expressed in YYYYMMDD format. This url information is found on all of pages 2-35 of Price Watch and pages 2-59 of Home Gain, respectively. The Examiner explained that the dates in the boxes in the lower right corner were the dates on which he had downloaded the individual pages from the Internet.

The Art Rejections

As addressed in greater detail below, Price Watch, Home Gain, and Grandcolas do not support the Official Action's reading of them and the rejections based thereupon should be reconsidered and withdrawn. Further, the Applicants do not acquiesce in the analysis of Price Watch, Home Gain, and Grandcolas made by the Official Action and respectfully traverse the Official Action's analysis underlying its rejections. It is noted that both the Price Watch and Home Gain materials contain pages that are clearly not prior art and it is not admitted that these items are prior art. Additionally, Grandcolas is not prior art as the present invention was reduced to practice at least as early as a date prior to the Grandcolas publication date. However, in light of the differences between the claims as presently amended and the relied upon items, Applicants have not at this time undertaken the burden of establishing a date of invention prior to their filing date.

Even if the art were considered to be prior art, it does not affect the patentability of Applicants' invention as now claimed. Among its several aspects, the presently claimed

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invention is directed generally to advantageous methods and systems for marketing of products, offers, or the like, and more particularly, to techniques for identifying consumers who are members of a designated category which has been judged to be a desirable market for a class of products and presenting special offers to consumers who have been identified as members of the designated category. See, the present specification at par. 1, for example. More particularly, the preamble of claim 1 reads "An offer presentation system for identifying consumers as belonging to a designated category and allowing access to offers by consumers who are members of the designated category." While several examples of such categories are discussed in the present application, such as recent high school or college graduates, people who are getting married or who have just gotten married, families sending children to college, and relocating families, see, par. 2, for example, an exemplary embodiment of the invention addresses consumers identified as relocating based upon their interest in applying for a loan or their application for a loan. In this context, as indicated at par. 21, lines 14-16, "identification of a consumer as soon as he or she applies for or inquires about a home loan allows for marketing of products and services tailored to all stages of the relocation process." As seen in Fig. 9B, exemplary offers from vendors such as Home Depot, GE, and Penske are made available.

At this fundamental level, the present claims differ significantly from Price Watch. As indicated at page 2 in answer to the question "Who is Price Watch?", it is stated that "Price Watch Corporation is an independent research firm that studies the street prices of computer components." As shown at pages 5 and 7, for example, a wide variety of products are listed as well as a number of sellers. Apparently, anyone can use the site thereby becoming a Price Watch user, and the same offers are available to any Price Watch user. While Price Watch users could

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possibly be a considered category of consumers, there isn't any "identifying" of consumers as belonging to this category.

Furthermore, claim 1 continues as follows: "a database of offers accessible through connection by consumer operated computers upon authentication of consumer registration." While Price Watch does appear to have "a database of offers accessible through connection by consumer operated computers", it does not meet the remainder of the language defining this claim element: "upon authentication of consumer registration". From the relied upon pages or even upon going to the current Price Watch web site, there does not appear to be any registration of "consumers" or "authentication of consumer registration" as claimed by claim 1.

The Official Action directs attention to p. 26, but this page shows an "Advertiser Application" for dealers or retailers, and not consumers. Using page 26, dealers apply to advertise their prices on the Price Watch system. Later, the Official Action appears to equate the "vendors" of page 26 of Price Watch to "consumers." However, even if vendors are somehow considered "consumers", they also appear able to access all of the offers made available through the Price Watch system just as true consumer users are able to do, and their access to offers is in no way keyed to "identifying" them "as belonging to the designated category" and offers do not appear to be tailored based upon "identifying" them "as belonging in the designated category". Even turning claim 1 on its head as the Examiner apparently proposes to do, it does not read on Price Watch.

The next element of claim 1 is "an offer presentation module for managing access to the database of offers." While Price Watch, as described previously, does implicitly appear to have a database of offers, there does not appear to be "an offer presentation module for managing

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access" to that database. By way of example, the present specification describes a variety of ways in which access to offers can be advantageously managed in accordance with the present invention. For example, paragraph 35 addresses predefined conditions being met so that the system (1) distinguishes between borrowers accessing an offer for the first time from those who are accessing the offer for a second or subsequent time, (2) identifies a borrower as associated with a particular lender, or (3) determines if a specified amount of time has passed since initial registration. Paragraphs 53 and 54 address the provision of different sets of offers to borrowers introduced by different lenders. While it is clear that other management choices can be made consistent with this invention, no such choices are made by Price Watch which appears to display all offers to all consumers who choose to use the site based on their selections while using the site.

Finally, the last element of claim 1 is "a consumer registration module allowing registration of a consumer for access to the offer presentation module, the consumer registration module allowing registration of a consumer upon submission of identifying information provided to the consumer by a party who has verified the consumer's membership in the designated category and used to identify the consumer as belonging to the designated category." Of course, Price Watch which apparently allows access to all consumers does not meet this element as correctly admitted by the Office Action at p. 4.

The Office Action, however, relies upon Home Gain's disclosure at p. 52 as meeting this element and providing a basis for modifying Price Watch. The Office Action refers specifically to "licensed agents who are affiliated with a broker" and specifically concludes:

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Price Watch as taught by Home Gain to be able to limit the access to of the system and method to registered vendors only.

As an initial matter, it is again noted that claim 1 and the element under analysis both refer to "consumers" and not vendors. It is submitted that the "licensed agent" of Home Gain is not a "consumer" as claimed. In Home Gain, the consumers are individuals who want to list their homes with a realtor for sale or who are looking for a realtor to help them buy a home. Similarly, the vendors of Price Watch are not "consumers" as noted above. The Price Watch consumers are the users who access the site, get a price and call a vendor regarding a product they want to purchase.

Further, Price Watch makes a conscious choice not to register vendors. For example, page 2 has the following question and answer:

If a dealer is listed on your site can I assume that I will not encounter any problems during my purchase?

Keep in mind that we are an independent research firm and do not endorse any dealer....It is up to you to decide if you want to do business with a firm.

Page 25 is similar and states, "Keep in mind that prices shown on our site are advertisements." In other words, caveat emptor. As a result, it clearly is contrary to Price Watch's own teachings to modify it in the manner suggested by the Examiner, and it is not obvious to do so.

Dependent Claims 2-7

Regarding dependent claims 2-6, Price Watch does not disclose a consumer registration module. Its registration of vendors or dealers offering a product or products for sale does not

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meet the terms of these claims. Similarly, the registration of real estate agents in Home Gain does not teach and does not make obvious the claimed subject matter of these dependent claims. In Home Gain, homeowners post profiles online, p. 4, but there does not appear to be any requirement of the "submission of identifying information provided to the consumer by a party who has verified the consumer's membership in the designated category." Further, pp. 6 and 7 of Home Gain apparently show representative home seller and home buyer profiles. From these pages, there is no indication that "a unique consumer username and password" is selected as in claim 2; that this information is associated with solicited "personal information" as claimed in claim 3; or that the consumer username is associated with "the identifying information" as in claim 4.

With respect to claim 7, this claim recites "wherein one or more offers is accessible only if predetermined conditions have been met". The Official Action states "Price Watch in view of Home Gain teaches one or more offers is accessible only if predetermined conditions have been met (customers looking [for] fans for hard-drive processors)" directing attention to Price Watch p. 23. This page 23 apparently shows a display for "Query = Fans Hard Drive". There does not appear to be any predetermined condition met in the sense that this term is used in claim 7 when interpreted in light of the specification. It appears anyone who goes to the Price Watch site and queries "Fans Hard Drive" can freely access this, page 23. In this regard, it is noted that page 14 shows a link for "Fans" under the heading "CPU" and that page 18 shows a link "Hard Drive" under a heading "Fans".

As noted above, paragraphs 35, 53, and 54 address examples of how identification of a borrower may be used to insure predetermined conditions are met in order to control access to

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offers. For example, the borrower has not accessed the offer previously, has accessed the offer only a specified number of times, or only a specified time, such as a year, has passed since registration, or only selected offers are presented to borrowers identified with a particular lender.

The analysis of the Office Action is akin to saying that a Price Watch user can only gain access if the site is up and running or if his or her computer receives electrical power so consequently the offers are accessible only if predetermined conditions are met. It is submitted that such analysis does an injustice to the meaning of the claims when considered as a whole by one of ordinary skill in the art as they must be under 35 U.S.C. 103.

Method Claims 14-17

Claim 14 has been amended to address the 35 U.S.C. 101 rejection. With respect to the art rejections, as presently amended, claims 14-17 are allowable on the same grounds presented above for claims 1-7.

Section 103 Rejection of Claims 8-13 and 18-20

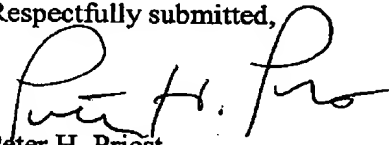
These claims were rejected over Price Watch and Home Gain in further view of Grandcolas. Grandcolas shows a publication date of April 4, 2001. While Grandcolas does not appear in fact to be "prior" art, it does not cure the deficiencies of the principal references discussed above, and consequently these claims should be promptly allowed. In the event that the present rejection is maintained, the Examiner is requested to reject these claims on all possible grounds so that if the Applicants undertake the burden of searing behind Grandcolas, they will not be unfairly surprised by a new rejection of these claims on new and different art.

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Conclusion

All of the presently pending claims, as amended, appearing to define over the applied references, withdrawal of the present rejection and prompt allowance are requested.

Respectfully submitted,



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Exhibit A

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Searching Page - M60234 Internet Explorer provided by USP10

http://web.archive.org/web/http://www.pricewatch.com

INTERNET ARCHIVE
Wayback Machine

Enter Web Address: <http://www.pricewatch.com> Ad

Searched for <http://www.pricewatch.com> 138 Results

Note: some duplicates are not shown. Search * denotes when site was updated.

Search Results for Jan 01, 1996 - Nov 23, 2002

1996	1997	1998	1999	2000	2001	2002
Dec 20, 1996 *	Feb 09, 1997 *	Jan 15, 1998	Jan 25, 1998	Feb 29, 2000	Jan 08, 2001	Jan 24, 2002 *
	Feb 09, 1997 *	Dec 05, 1998 *	Feb 02, 1999	Mar 01, 2000	Jan 18, 2001	Jan 24, 2002 *
	Apr 18, 1997 *	Dec 12, 1998	Feb 08, 1999	Mar 02, 2000	Mar 01, 2001	
	Jun 14, 1997 *		Apr 17, 1999	Mar 03, 2000	Mar 02, 2001	
	Oct 07, 1997 *		Apr 27, 1999	Mar 04, 2000	Apr 01, 2001	
	Dec 12, 1997 *		May 01, 1999	Apr 08, 2000	Apr 05, 2001	
			Oct 12, 1999 *	May 10, 2000	Apr 18, 2001	
				May 11, 2000	May 05, 2001	
				May 12, 2000	May 07, 2001	
				May 20, 2000	May 09, 2001	
				Jun 20, 2000 *	May 10, 2001	
				Jun 21, 2000	May 12, 2001	
				Jun 22, 2000	May 13, 2001	
				Aug 15, 2000 *	May 14, 2001	
				Oct 17, 2000 *	May 15, 2001	
				Oct 18, 2000	May 16, 2001	
				Oct 19, 2000	May 18, 2001	
				Oct 27, 2000	May 19, 2001	
				Dec 02, 2000	May 20, 2001	
				Dec 18, 2000	May 21, 2001	
				Dec 19, 2000	May 23, 2001	
					May 27, 2001	
					May 30, 2001	
					May 31, 2001	
					Jun 02, 2001	
					Jun 05, 2001	
					Jun 06, 2001	
					Jun 15, 2001	
					Jun 16, 2001	
					Jun 17, 2001	
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					Jun 19, 2001	
					Jun 20, 2001	
					Jun 24, 2001	
					Jun 28, 2001	
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					Jul 07, 2001 *	
					Jul 09, 2001	
					Jul 10, 2001	
					Jul 11, 2001	
					Aug 22, 2001	

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